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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,544	03/23/2004	Alain Yang	D0932-00403	2495

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EXAMINER	
GOFMAN, ANNA	
ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 12/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/806,544	YANG ET AL.	
	Examiner	Art Unit	
	Anna Gofman	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *28-35* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *03/04;09/04;10/04;*. 02/05
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-27, drawn to a liquid absorbent material, classified in class 442, subclass 327.

   II. Claims 28-35, drawn to a process of making a liquid absorbent material, classified in class 264, various subclasses..

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made using a different method such as by a wet laid process or hydroentangling.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Won Joon Kouh on November 28, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-27. Affirmation of this election must be made by Applicant in replying to this Office action. Claims 28-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims "the liquid sorbent material of claim 22, wherein said core material and said sheath material are same thermoplastic polymer but of different formulations." It is vague and unclear what Applicant implies by "different formulations." Thus, claim 25 is rejected.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1-6, 11-15, 17-23, 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kajander et al. (US 2003/0008586).

Kajander et al. teach a water soluble nonwoven mat comprising a plurality of plastic-containing bi-component fibers with a polyester core and a sheath of polyethylene (par. 0010), which is inherently a thermoplastic polymer. Further, the sheath material inherently has a lower melting point temperature than that of the core

material. These fibers may be organic, such as cellulose, wood, and cotton fibers, or inorganic fibers, such as rotary glass fibers (par. 0010 and 0019), which inherently may be mono-component fibers. On paragraph 0030, Kajander et al. disclose that said mat has a thickness of 5/8 inches thick (or 15.9 mm) and a density of 45 pounds per cubic foot, implying a uniform density (and thus, a uniform blend) throughout the laminate. The inorganic glass fibers have diameters in the range of about 6 to about 23 microns and lengths of about 0.25 inches (or 0.635 cm) (par. 0018). The plastic-containing fibers make up about 20 weight percent (par. 0027) of the material. Thus, claims 1-6, 11-15, 17-23, 26-27 are rejected.

9. The recitation, "a liquid sorbent material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 7-10, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajander et al.

The features of Kajander et al. have been set forth above. Kajander et al. is silent about the density and weight of the fibrous structure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the desired density and weight through the process of routine experimentation in order to arrive at values which offered the optimum insulation in the invention of Kajander et al. Thus, claims 7-10 are rejected.

Further, Kajander et al. teach that the glass fibers have a length of about 6.35 mm, but disclose that fibers of various lengths can also be used to attain different characteristics in a known manner. The longer the fiber, the poorer the fiber dispersion (par. 0019). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the desired fiber length through the process of routine experimentation in order to arrive at values which offered the optimum fiber distribution in the invention of Kajander et al. Thus, claim 16 is rejected.

12. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajander et al. in view of Frank et al. (US 6,479,416).

The features of Kajander et al. have been set forth above. Kajander et al. is silent about a having mineral core in the bi-component fibers. Frank et al. is drawn to composite materials containing bi-component thermoplastic fibers. Frank et al. teach an absorbent material comprising thermoplastic bi-component fibers which bond to each other. These fibers may contain mineral fibers (pg.1 par.2 lines 49-53). It would have

been obvious to one having ordinary skill in the art at the time of the invention to make the bi-component fibers comprise mineral, as taught by Frank et al., in the invention of Kajander et al., motivated to provide strength and additional insulation to the fibrous material. Thus, claims 24-25 are rejected.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24-37 of copending Application No. 2005/0170734. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are drawn to insulating materials comprising glass and plastic-containing fibers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 1-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24-59 of copending Application No. 2005/0130538. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions are drawn to insulating materials comprising glass and plastic-containing fibers.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition to the references provided by Applicant, the follow documents are considered pertinent to Applicant's invention:

Jaffee (US 2004/0266304) teach a gypsum board comprising mineral and glass fibers, but not bi-component fibers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Gofman whose telephone number is (571) 272-7419. The examiner can normally be reached on Mon.-Fri. 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anna Gofman
Examiner
Art Unit 1771

AG